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| APPLICATION NO.                                                                             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/620,486                                                                                  | 07/16/2003  | Till Cramer          | DT-6580             | 9074             |
| 30377                                                                                       | 7590        | 11/01/2005           | EXAMINER            |                  |
| DAVID TOREN, ESQ.<br>ABELMAN FRAYNE & SCHWAB<br>666 THIRD AVENUE<br>NEW YORK, NY 10017-5621 |             |                      | SMITH, MATTHEW J    |                  |
|                                                                                             |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                             |             |                      | 3672                |                  |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |               |
|------------------------------|------------------|---------------|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)  |
|                              | 10/620,486       | CRAMER ET AL. |
|                              | Examiner         | Art Unit      |
|                              | Matthew J. Smith | 3672          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 September 2005.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-9 and 11-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 15 and 18 is/are allowed.  
 6) Claim(s) 1,3 and 11-14 is/are rejected.  
 7) Claim(s) 4-9, 16 and 17 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The "overlap from a small central zone up to an entire bore hole radius upon rotation of the concrete drill" is not supported by the specification or drawings. Since striking part 2 is clearly inside cutting part 1, the overlap cannot be from a small central zone to the perimeter of cutting part 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDonell (1863928).

MacDonell discloses a concrete drill for a rotary and percussively driven machine comprising a cutting part 10 and a striking part 2 axially limited and displaceable relative to the cutting part; the cutting part 10 and the striking part 2 each have, at their facial surfaces, zones for working a bore hole surface; the respective facial surface work zones of the cutting part and the striking part radially overlapping, Fig. 4, upon rotation of the drill; the leading end of the cutting part 10 and the striking part 2 form a common mantle head surface at an axial intermediate position (Fig. 2); and the head end leading end has a space, note Fig. 4, in a transverse plane, configured segmental with a large surface area.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonell in view of Hjalsten et al. (3259403).

MacDonell discloses a concrete drill for a rotary and percussively driven machine comprising a cutting part 10 and a striking part 2 axially limited and displaceable relative to the cutting part; the cutting part 10 and the striking part 2 each have at their facial surfaces zones for working a bore hole surface, the respective facial surface work

zones of the cutting part and the striking part radially overlap, Fig. 4, upon rotation of the drill; and the cutting part 10 is spring-biased by a spring 6 that is axially biased against an insertion end but not a very wear-resistant material or a hand tool machine.

Hjalsten et al. present very wear resistant hard metal inserts 19 in a percussion drill.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use hard materials, as presented by Hjalsten et al., in order to increase wear of the bit.

It would have been further obvious to use the device in a hand tool since it is well known to fabricate the structure of the MacDonell device in a scale for any size drilling machine.

#### ***Allowable Subject Matter***

Claims 15 and 18 are allowed.

Claims 4-9, 16, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Upon further consideration, the examiner has withdrawn the objection to claim 2.

The examiner contends applicants' striking part 2 does not extend to the outside diameter of cutting part 1. Thus this limitation is challenged under 112 first paragraph and not considered a structural limitation to claim 1. Ergo, amended claim 1 is anticipated by MacDonell since the structure, up to this challenged limitation, i.e., the striking part and the cutting part are disclosed. The examiner apologizes for not advancing prosecution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagwell  
Supervisory Patent Examiner  
Art Unit 3672

MJS MJS  
26 October 2005